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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,289	11/02/2001	Uday C. Sagi	29505/PF02186NA	9027

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EXAMINER

NGUYEN, DUC M

ART UNIT	PAPER NUMBER
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2685

DATE MAILED: 01/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/000,289

Applicant(s)
Sagi et al

Examiner
Duc M. Nguyen

Art Unit
2685



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 20, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

This action is in response to applicant's response filed on 10/20/03. Claims 1-34 are now pending in the present application. **This action is made final.**

Claim Objections

1. Claim 11 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 11 recites a limitation which already recited in claim 1. Accordingly, it is suggested that claim 11 be canceled.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable by **Ogle** (US Pat. Number **6,430,604**) in view of **Woltz** (US Pat No. **6,216,165**).

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Regarding claim 1, **Ogle** discloses a system for enabling message system to deliver instant messages to a subscriber based on the subscriber profile (see **Abstract, Figs. 5F1, 5F2, 5G**) which would include all the claimed limitation except for the message is routed to two different devices, wherein the registry would read on the “subscriber profile” as claimed (see **Fig. 3, col. 7, line 23 - col. 8, line 67**), the instant messages would read on “real-time communication message” as claimed (see **col. 1, lines 20-23**). Here, although **Ogle** fails to disclose the message is routed to two different devices, in an analogous art, **Woltz** however discloses a system for enabling message system to deliver a message to a subscriber based on the subscriber profile, wherein a first component (i.e, header notification) and a second component (i.e, content information, newsletter or attachment) of the message are delivered each to a different device (see **col. 5, line 60 - col. 6, line 48**). Therefore, it would have been obvious to one skill in the art to provide the above teaching of **Woltz** to **Ogle** for sending components of a message to two different devices (i.e, pager and computer) at two formats (i.e, pager and TCP/IP formats) as claimed, as an enhanced service to the user (i.e, a traveling user would be aware of a message that has been received at home).

Regarding claim 14, the claim is rejected for the same reason as set forth in claim 1 above. In addition, **Ogle** discloses a gateway and servers as claimed (see **Fig. 2, col. 5, lines 20-40**).

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Regarding claim **23**, the claim is rejected for the same reason as set forth in claim 1 above. In addition, **Ogle** discloses a computer-readable medium as claimed (see col. 6, lines 1-65 and columns 15-16).

Regarding claims **2, 15, 24**, the claims are rejected for the same reason as set forth in claims 1, 14, 23 above. In addition, **Ogle** discloses one of text, voice messages as claimed (see col. 9, lines 43-59).

Regarding claims **3, 17, 25**, the claims are rejected for the same reason as set forth in claims 1, 14, 23 above. In addition, **Ogle** discloses operating information (time) of one of devices as claimed (see Fig. 3).

Regarding claims **4, 18, 26**, the claims are rejected for the same reason as set forth in claims 1, 14, 23 above. In addition, **Ogle** discloses one of informations as claimed (see Fig. 3, col. 7, line 57 - col. 8, line 67).

Regarding claims **5-6, 19, 27-28**, the claims are rejected for the same reason as set forth in claims 1, 14, 23 above. In addition, since indicating a preference format for a device in the subscriber profile is known in the art (Official Notice), it would have been obvious to one skill in the art to modify **Ogle** and **Woltz** for providing a preference format as claimed, for providing the user a personalize service as an enhanced feature.

Regarding claims **7, 29**, the claims are rejected for the same reason as set forth in claim 1, 14, 23 above. In addition, **Ogle** discloses formats conversion as claimed (see Fig. 5F2, ref. 730 and col. 9, lines 43-59).

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Regarding claims **8, 30**, the claims are rejected for the same reason as set forth in claims 1, 14, 23 above. In addition, **Ogle** discloses formats conversion in response to a subscriber input as claimed (see col. 10, lines 8-46), wherein it is clear that when selecting an alternative delivery option by the user input which has a different format, the message format would obviously be converted to the alternative delivery format (see col. 8, lines 7-67) in order to delivery the message without error.

Regarding claim **9**, the claim is rejected for the same reason as set forth in claim 1 above. In addition, **Ogle** discloses one of formats conversion as claimed (see Fig. 5F2, ref. 730 and col. 9, lines 43-59).

Regarding claim **10**, the claim is rejected for the same reason as set forth in claim 1 above. In addition, since such GIF and WBMP formats are known in the art (Official Notice), it would have been obvious to one skill in the art to modify **Ogle** and **Woltz** for using format as claimed, for cost saving.

Regarding claims **11-12, 31-32**, the claims are interpreted and rejected for the same reason as set forth in claims 1, 14, 23 above.

Regarding claims **13, 22, 33**, the claims are rejected for the same reason as set forth in claims 1, 14, 23 above. In addition, **Ogle** discloses an instant message as claimed.

Regarding claim **16**, the claim is rejected for the same reason as set forth

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in claim 14 above. In addition, since routing a multi-media message is known in the art (Official Notice), it would have been obvious to one skill in the art to modify **Ogle** and **Woltz** for providing a message as claimed, for providing the service as an enhanced feature to users.

Regarding claims **20-21**, the claims are rejected for the same reason as set forth in claim 1 above. In addition, **Ogle** discloses protocols as claimed (see Fig. 2, col. 5, lines 44-67).

Regarding claim **34**, the claim is rejected for the same reason as set forth in claim 23 above. In addition, **Ogle** discloses the medium comprises one of components as claimed (see Fig. 2).

Response to Arguments

4. Applicant's arguments filed 10/20/03 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the real time communication message is **analyzed** and **separated** into components **based on format** of the components ... as argued by the Applicant on page 11, lines 7-12) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Here, by sending header information of the message to the pager of the subscriber, this would read on the limitation "a first component (headers) of the message having a first format (pager format) is arranged for transmission to the first wireless device (pager)

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operated by the second subscriber” as claimed. Further, by sending the entire message, which comprises first and second components, to the computer (or e-mail box) of the subscriber, this would read on the limitation “a second component (content information or attachment) of the message having a second format (formats of content information or attachment) is arranged for transmission to the second communication device (computer) operated by the second subscriber” as claimed. Therefore, it is believed that the combination of **Woltz** and **Ogle** would read on claimed limitation of claims 1, 14, 23.

For foregoing reasons, the examiner believes that the pending claims are not allowable over the cited prior art.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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6. **Any response to this final action should be mailed to:**

Box A.F.

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

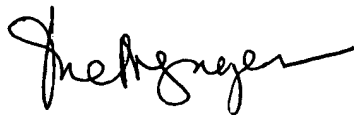
(for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington VA, Sixth Floor (Receptionist).

Any inquiry concerning this communication or communications from the examiner
should be directed to Duc M. Nguyen whose telephone number is (703) 306-4531, Monday-
Thursday (9:00 AM - 5:00 PM). Or to Edward Urban (Supervisor) whose telephone number is
(703) 305-4385.

Any inquiry of a general nature or relating to the status of this application should be
directed to the Group receptionist whose telephone number is (703) 305-4700.

Duc M. Nguyen



Dec 28, 2003